



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,253	06/30/2000	Jay S. Walker	00-007	1960
22927	7590	04/07/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			KAPADIA, MILAN S	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 04/07/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,253

Applicant(s)

WALKER ET AL.

Examiner

Milan S Kapadia

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-47, 50, 59 and 116-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-47, 50, 59 and 116-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 18 October 2000. Claims 2-47, 49, 50 and 116-125 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-5, 18-31, 37-39, 43-47, 49-50, 116-118, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632) in view of Kehr et al. (4,768,177) and further in view of de la Huerga et al. (5,852,590).

(A) As per claim 2, Reber teaches a method for use by a first container that is adapted to store a first medicine (Reber; col. 7, lines 60-67), the method comprising:

storing information regarding the first medicine (Reber; col. 7, lines 60-67).

Reber fails to expressly teach communicating a signal between the first container and a second container, the second container adapted to store a second medicine. However, this

Art Unit: 2144

feature is old and well known in the art, as evidenced by Kehr's teachings with regards to communicating a signal between the first container and a second container, the second container adapted to store a second medicine (Kehr; abstract and col. 12, line 55-col. 13, line 11). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber with Kehr's teaching with regards to this limitation, with the motivation of using a cost-effective way to assure multiple medications are taken properly (Kehr; col. 3, lines 25-31).

The combined system of Reber and Kehr collectively fail to expressly teach the signal is communicated wirelessly. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to wirelessly communicating a signals for medication containers (de la Huerga; abstract and col. 13, line 57-col. 14, line 24). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of transferring desired data using a well-known form of communication

(B) As per claim 3, the combined system of Reber and Kehr collectively fail expressly teach wherein wirelessly communicating a signal between the first container and a second container comprises at least one of transmitting information regarding the first medicine from the first container to the second container and receiving information regarding the second medicine from the second container. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to wherein wirelessly communicating a signal between

Art Unit: 2144

the first container and a second container comprises at least one of transmitting information regarding the first medicine from the first container to the second container (de la Huerga; col. 14, lines 6-24) and receiving information regarding the second medicine from the second container (de la Huerga; col. 14, lines 6-24). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of communicating instructions for alternating between differing medications in a controlled sequence (de la Huerga; col. 3, col. 3, line 64-col. 4, line 6).

(C) As per claim 4, the combined system of Reber and Kehr collectively fail to expressly teach generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine (de la Huerga; col. 13, lines 26-46). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of monitoring patient compliance to prescription regiment (de la Huerga; col. 13, lines 26-46).

(D) As per claim 5, the combined system of Reber and Kehr collectively fail to

Art Unit: 2144

expressly teach outputting the at least one code to at least one of a representative of an insurance company, a representative of a pharmacy and a representative of a medical facility. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to outputting the at least one code to at least one of a representative of an insurance company, a representative of a pharmacy and a representative of a medical facility (de la Huerga; col. 13, lines 26-46). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of monitoring patient compliance to prescription regiment (de la Huerga; col. 13, lines 26-46).

(E) As per claims 18 and 19, Reber teaches receiving and storing information regarding a schedule for taking at least one of the first medicine and the second medicine (Reber; col. 2, lines 48-65).

(F) As per claim 20, Reber teaches wherein receiving information regarding a schedule for taking the first medicine comprises receiving the information regarding the schedule from at least one of a representative of an insurance company, a representative of a pharmacy, a representative of a medical facility, a representative of a manufacturer of at least one of the first and the second medicines and a party that is to take at least one of the first and the second medicines (Reber; col. 3, lines 50-58).

(G) As per claim 21, Reber teaches storing the first medicine in the first container

(Reber; col. 2, line 66-col. 3, line 8).

(H) As per claim 22, Reber teaches detecting if a portion of the first medicine has been removed from the first container (Reber; col. 8, lines 50-62).

(I) As per claim 23, the combined system of Reber and Kehr collectively fail to expressly teach wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting if the first container has been opened or closed. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting if the first container has been opened or closed (de la Huerga; col. 3, lines 27-35). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of keeping inventory information regarding the number of medication doses remaining in the container (de la Huerga; col. 3, lines 30-33).

(J) As per claim 24, the combined system of Reber, Kehr and de la Huerga collectively fail to expressly teach wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting a weight of the first container. However, since in the medical arts the weight of various medications are known and the difference between weightings of the medical containers can be used to determine the portion of the first medicine

that has been removed, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system of Reber and de la Huerga to detect if a portion of the first medicine has been removed from the first container by detecting a weight of the first container, with the motivation of keeping inventory information regarding the number of medication doses remaining in the container (de la Huerga; col. 3, lines 30-33).

(K) As per claim 25, the combined system of Reber and Kehr collectively fail to expressly teach wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting a count of the first medicine. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to wherein detecting if a portion of the first medicine has been removed from the first container comprises detecting a count of the first medicine (de la Huerga; col. 13, lines 47-56). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of keeping inventory information regarding the number of medication doses remaining in the container (de la Huerga; col. 3, lines 30-33).

(L) As per claim 26, Reber teaches at least one of storing information regarding the portion and transmitting the information regarding the portion if the portion has been removed from the first container (Reber; col. 11, lines 55-67).

(M) As per claim 27, Reber teaches detecting if the second medicine has been stored in the second container (Reber; col. 11, lines 55-67).

(N) As per claim 28, Reber teaches detecting if a portion of the second medicine has been removed from the second container (Reber; col. 8, lines 50-62).

(O) As per claim 29, Reber teaches wherein detecting if the portion of the second medicine has been removed from the second container comprises receiving a signal from the second container that indicates that the portion of the second medicine has been removed from the second container (Reber; col. 8, lines 50-62).

(P) As per claim 30, Reber teaches at least one of storing information regarding the portion and transmitting the information regarding the portion if the portion has been removed from the second container (Reber; col. 11, lines 55-67).

(Q) As per claim 31, the combined system of Reber and Kehr collectively fail to expressly teach storing the information regarding the second medicine, the information being stored within the first container. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to storing the information regarding the second medicine, the information being stored within the first container (de la Huerga; col. 3, line 64-col. 4, line 6 and col. 14, lines 6-24). It is respectfully submitted, that it would have been

Art Unit: 2144

obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of communicating instructions for alternating between differing medications in a controlled sequence (de la Huerga; col. 3, col. 3, line 64-col. 4, line 6).

(R) As per claims 37 and 38, the combined system of Reber and Kehr collectively fail to expressly teach receiving information regarding the second medicine stored within the second container and wherein receiving information regarding the second medicine stored within the second container comprises receiving information transmitted by the second container. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to receiving information regarding the second medicine stored within the second container and wherein receiving information regarding the second medicine stored within the second container comprises receiving information transmitted by the second container (de la Huerga; col. 14, lines 6-24). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of communicating instructions for alternating between differing medications in a controlled sequence (de la Huerga; col. 3, col. 3, line 64-col. 4, line 6).

(S) As per claim 39, the combined system of Reber, Kehr and de la Huerga collectively fail to expressly teach wherein the first and second medicines are the same medicine. However, since the combined system of Reber and de la Huerga clearly teach the medication

Art Unit: 2144

containers containing any medicines that are desired (Reber; col. 7, lines 60-66) and it is known to be able to obtain medication containers with identical medications at drug and grocery stores, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to gather information as required by Reber, Kehr and de la Huerga using any desired medication in the containers, even the same medicine if desired, with the motivation of meeting the prescription requirements.

(T) As per claims 43 and 44, the combined system of Reber and Kehr collectively fail to expressly teach tracking a number of times the first and second containers is opened or closed. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to tracking a number of times the first and second containers is opened or closed (de la Huerga; col. 12, line 63-col. 13, line 46). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of preventing a patient from consuming too many pills in too short of a time (de la Huerga; col. 3, lines 19-22).

(U) As per claim 45, the combined system of Reber and Kehr collectively fail to expressly teach receiving a signal from the second container each time the second container is opened or closed and counting a number of signals received from the second container. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings

with regards to receiving a signal from the second container each time the second container is opened or closed and counting a number of signals received from the second container (de la Huerga; col. 12, line 63-col. 13, line 46). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation of preventing a patient from consuming too many pills in too short of a time (de la Huerga; col. 3, lines 19-22).

(V) As per claim 46, the combined system of Reber and Kehr collectively fail to expressly teach storing at least a portion of medical history of a party within the first container. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards to storing at least a portion of medical history of a party within the first container (de la Huerga; col. 10, lines 18-43). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and Kehr with de la Huerga's teaching with regards to this limitation, with the motivation containing a wide variety of information that is not practical to print out in textual form on a relatively small label (de la Huerga; col. 3, lines 42-45).

(W) As per claim 47, Reber teaches storing information regarding a third medicine in the first container if the first container is refilled with the third medicine (Reber; col. 13, lines 64-67).

(X) System claim 49 repeats the subject matter of method claim 2, as a set of apparatus elements rather than a series of steps. As the underlying processes of claim 2 has been shown to be fully disclosed by the teachings of Reber, Kehr and de la Huerga in the above rejections of claim 2, it is readily apparent that the system disclosed by Reber, Kehr and de la Huerga includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(Y) As per claim 50, Reber teaches wherein the communication device comprises a transceiver (Reber; col. 4, lines 28-41).

(Z) Claims 116 and 117 repeat the features of claim 1 and are therefore rejected for the same reasons given above in the rejection of claim 1 and incorporated herein.

(AA) As per claim 118, the combined system of Reber and de la Huerga collectively fail to expressly teach positioning the first container and the second container so that the first container and the second container may communicate. However, this feature is old and well known in the art, as evidenced by Kehr's teachings with regards to positioning the first container and the second container so that the first container and the second container may communicate (Kehr; abstract and col. 12, line 55-col. 13, line 11). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Reber and de la Huerga with Kehr's teaching with regards to this

Art Unit: 2144

limitation, with the motivation of using a cost-effective way to assure multiple medications are taken properly (Kehr; col. 3, lines 25-31).

(BB) As per claim 125, Reber teaches obtaining a refill for the first container (Reber; col. 13, lines 64-66).

4. Claims 6-8, 41-42, and 119-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177) and de la Huerga et al. (5,852,590) as applied to claims 2 and 118 above and further in view of Mauney et al. (6,484,027).

(A) As per claim 6, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach detecting if the first container and the second container cannot communicate. However, this feature is old and well known in the art, as evidenced by Mauney's teachings with regards to detecting if a first wireless device and a second wireless device cannot communicate (Mauney; abstract col. 7, lines 39-55, and col. 8, lines 43-53). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with Mauney's teaching with regards to this limitation, with the motivation of determining if the medication containers are in range to communicate (Mauney; col. 7, lines 39-44).

Art Unit: 2144

(B) As per claim 7, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach determining if the first container and the second container are separated by a distance that prevents the first container and the second container from communicating. However, this feature is old and well known in the art, as evidenced by Mauney's teachings with regards to determining if the first container and the second container are separated by a distance that prevents the first container and the second container from communicating (Mauney; abstract col. 7, lines 39-55, and col. 8, lines 43-53). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with Mauney's teaching with regards to this limitation, with the motivation of determining if the medication containers are in range to communicate (Mauney; col. 7, lines 39-44).

(C) As per claim 8, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach determining a time when the first container and the second container are at least initially separated by the distance that prevents the first container and the second container from communicating. However, this feature is old and well known in the art, as evidenced by Mauney's teachings with regards to determining a time when the first container and the second container are at least initially separated by the distance that prevents the first container and the second container from communicating (Mauney; col. 32, line 61-col. 33, line 6). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in

the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with Mauney's teaching with regards to this limitation, with the motivation of determining if the medication containers are in range to communicate (Mauney; col. 7, lines 39-44).

(D) As per claim 41, the combined system of Reber, Kehr, de la Huerga, and Mauney collectively teach determining if the first container is positioned so as to communicate with the second container as shown above in the rejection of claim 6 and incorporated herein. The combined system of Reber, de la Huerga, and Mauney collectively fail to expressly teach attempting to prevent a party from accessing at least one of the first and second medicines if the first and second containers cannot communicate. However, the combined system of Reber, Kehr, de la Huerga, and Mauney collectively teach that certain medications need to be taken together (de la Huerga; col. 3, line 64-col. 4, line 6) and also teach preventing a party from accessing at least one of the first and second medicines (de La Huerga; col. 12, lines 29-60). As such, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr, de la Huerga, and Mauney to attempt to prevent a party from accessing at least one of the first and second medicines if the first and second containers cannot communicate, with the motivation of preventing a patient from taking a medication in situations where they would not be able to take all medications that may be required.

(E) As per claim 42, the combined system of Reber Kehr, and Mauney collectively fail

to expressly teach wherein preventing a party from accessing at least one of the first and the second medicines comprises preventing the party from opening at least one of the first and the second containers. However, this feature is old and well known in the art, as evidenced by de la Huerga's teachings with regards wherein preventing a party from accessing at least one of the first and the second medicines comprises preventing the party from opening at least one of the first and the second containers (de la Huerga; col. 12, lines 29-60). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and Mauney with de la Huerga's teaching with regards to this limitation, with the motivation of controlling the patient's ability to access and remove the medication until the next dose of medication is due according to the prescribed dosing regimen (de la Huerga; col. 12, lines 33-37).

(F) Claim 119 repeats the features of claim 6 and is therefore rejected for the same reasons given above in the rejection of claim 6 and incorporated herein.

(G) As per claim 120, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach providing the received code to at least one party. However, this feature is old and well known in the art, as evidenced by Mauney's teachings with regards to providing the received code to at least one party (Mauney; abstract col. 7, lines 39-55, and col. 8, lines 43-53). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system

taught by Reber, Kehr and de la Huerga with Mauney's teaching with regards to this limitation, with the motivation of determining if the medication containers are in range to communicate (Mauney; col. 7, lines 39-44).

(H) Claim 121 repeats the features of claim 5 and is therefore rejected for the same reasons given above in the rejection of claim 5 and incorporated herein.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177), de la Huerga et al. (5,852,590), and Mauney et al. (6,484,027) as applied to claim 8 above and further in view of McEwan (5,589,839).

(A) As per claim 9, the combined system of Reber, Kehr, de la Huerga, and Mauney teach that the medication containers are wireless devices (de la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach at least one of storing the time and transmitting the time. However, this feature is old and well known in the art, as evidenced by McEwan's teachings with regards to at least one of storing the time and transmitting the time (McEwan; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr, de la Huerga, and Mauney with McEwan's teaching with regards to this limitation, with the motivation of determining the position of the medication containers (McEwan; abstract).

Art Unit: 2144

6. Claims 10-17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177) and de la Huerga et al. (5,852,590) as applied to claim 2 above and further in view of McEwan (5,589,839).

(A) As per claims 10, 14, and 15, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach determining a distance between the first container and the second container based on the signal and tracking a location of at least one of the first and second containers with a local positioning system. However, this feature is old and well known in the art, as evidenced by McEwan's teachings with regards to determining a distance between the first container and the second container based on the signal and tracking a location of at least one of the first and second containers with a local positioning system (McEwan; col. 3, lines 15-36 and line 54-col. 4, line 3). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McEwan's teaching with regards to this limitation, with the motivation of determining the location of the medication containers (McEwan; col. 2, lines 25-30).

(B) As per claim 11, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach at least one of storing the distance and transmitting the distance. However, this feature is old and well known in the art, as evidenced by McEwan's

teachings with regards to at least one of storing the distance and transmitting the distance (McEwan; col. 3, lines 54-66). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McEwan's teaching with regards to this limitation, with the motivation of determining the location of the medication containers (McEwan; col. 2, lines 25-30).

(C) As per claim 12, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach determining a change in the distance between the first container and the second container based on the signal. However, this feature is old and well known in the art, as evidenced by McEwan's teachings with regards to determining a change in the distance between the first container and the second container based on the signal (McEwan; col. 3, lines 14-36). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McEwan's teaching with regards to this limitation, with the motivation of determining the location of the medication containers (McEwan; col. 2, lines 25-30).

(D) As per claim 13, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach at least one of storing the change in the distance and

transmitting the change in the distance. However, this feature is old and well known in the art, as evidenced by McEwan's teachings with regards to at least one of storing the change in the distance and transmitting the change in the distance (McEwan; col. 3, lines 54-66). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McEwan's teaching with regards to this limitation, with the motivation of determining the location of the medication containers (McEwan; col. 2, lines 25-30).

(E) As per claims 16 and 17, the combined system of Reber, Kehr and de la Huerga teach that the medication containers are wireless devices (del la Huerga; col. 11, lines 35-57) but collectively fail to expressly teach identifying the location of the at least one of the first and second containers with the local positioning system and obtaining information regarding a position of the at least one of the first and second containers with the local positioning system. However, this feature is old and well known in the art, as evidenced by McEwan's teachings with regards to identifying the location of the at least one of the first and second containers with the local positioning system and obtaining information regarding a position of the at least one of the first and second containers with the local positioning system (McEwan; col. 3, lines 15-36 and line 54-col. 4, line 3). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McEwan's teaching with regards to this limitation, with the motivation of determining the location of the medication containers (McEwan; col. 2, lines 25-30).

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177) and de la Huerga et al. (5,852,590) as applied to claim 2 above and further in view of official notice.

(A) As per claim 40, the combined system of Reber, Kehr and de la Huerga collectively fail to expressly teach wherein at least one of the first and second containers comprises a micro-needle based device. However, the combined system of Reber, Kehr and de la Huerga clearly teach the use of medication containers to deliver medicine (Reber; col. 7, lines 60-66). The examiner takes official notice that the use of micro-needle based devices to deliver medicine is well-known in the medical arts. Thus, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to deliver medicine as required by Reber, Kehr and de la Huerga using and known delivery mechanism, such as micro-needle based devices, with the motivation of meeting the prescription requirements.

8. Claims 122-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177), de la Huerga et al. (5,852,590), and Mauney et al. (6,484,027) as applied to claim 120 above and further in view of official notice.

(A) As per claims 122-124, the combined system of Reber, Kehr, de la Huerga, and

Mauney collectively fail to expressly teach wherein providing an image of the code, entering the received code during a telephone call and emailing the received code. However, the combined system of Reber, Kehr, de la Huerga, Mauney clearly teach notifying at least party the via the received code (Mauney; col. 7, lines 39-67). The examiner takes official notice that the use images, entry during a telephone call, and email to notify a party of an event is well-known in the computer arts. Thus, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to provide information as required by Reber, Kehr, de la Huerga, and Mauney using any well-known communication means, such as images, telephone entry and email, with the motivation of notifying the party of a particular event.

9. Claims 32-36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (5,950,632), Kehr et al. (4,768,177) and de la Huerga et al. (5,852,590) as applied to claim 28 above and further in view of McIntosh et al. (4,682,299).

(A) As per claims 32 and 33, the combined system of Reber, Kehr and de la Huerga collectively fail to expressly teach determining if the first medicine is incompatible with the second medicine and detecting if a party attempts to take the first medicine within a predetermined time period of taking the second medicine and generating a warning if the first medicine is incompatible with the second medicine if the first and second medicines are both taken during the predetermined time period. However, this feature is old and well known in the art, as evidenced by McIntosh's teachings with regards to determining if the first medicine is

incompatible with the second medicine and detecting if a party attempts to take the first medicine within a predetermined time period of taking the second medicine and generating a warning if the first medicine is incompatible with the second medicine if the first and second medicines are both taken during the predetermined time period (McIntosh; col. 15, line 66-col. 16, line 17). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McIntosh's teaching with regards to this limitation, with the motivation of revealing incompatibilities between medications (McIntosh; col. 3, lines 47-52).

(B) As per claims 34 and 35, the combined system of Reber, Kehr and de la Huerga collectively fail to expressly teach storing an indicator of the warning and transmitting an indicator of the warning. However, this feature is old and well known in the art, as evidenced by McIntosh's teachings with regards to storing an indicator of the warning and transmitting an indicator of the warning (McIntosh; col. 15, line 66-col. 16, line 17). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Reber, Kehr and de la Huerga with McIntosh's teaching with regards to this limitation, with the motivation of revealing incompatibilities between medications (McIntosh; col. 3, lines 47-52).

(C) Claim 36 repeats the features of claim 4 and is therefore rejected for the same reasons given above in the rejection of claim 4 and incorporated herein.

10. Applicant's arguments with respect to amended claims 3-6 have been considered but are moot in view of the new ground(s) of rejection.

(A) At pages 2-3 of the 1/5/04 communication, Applicant argues each of the applied references individually. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the applied references of record are clearly disclosed in the respective teachings of Kehr, when considered collectively with that of the applied references of record, as discussed in detail within a prior Office Action (paper number 8) and in the preceding rejections, and incorporated herein.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(B) At pages 3 and 4 of the 1/5/04 response, Applicant requests a reference or an affidavit to

support the Official Notice taken in the prior Office Action of “the use of micro-needle based devices to deliver medicine,” and “the use of images, entry during a telephone call, and email to notify a party of an event.”

In response, the Examiner hereby directs Applicant's attention to U.S. Patent No. 6,689,103 to Palasis (cited herewith), which clearly evidences the use of micro-needle based devices to deliver medicine (note especially abstract of Palasis). As such, the knowledge and use of the use of micro-needle based devices to deliver medicine, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Moreover, the Examiner hereby directs Applicant's attention to U.S. Patent No. 5,911,132 to Sloane (cited herewith), which clearly evidences the use of images, entry during a telephone call, and email to notify a party of an event (note especially abstract, col. 1, lines 10-24, and col. 6, lines 1-19 of Palasis). As such, the knowledge and use the use of images, entry during a telephone call, and email to notify a party of an event, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a multi-vial medication organizer and dispenser (6,259,654);

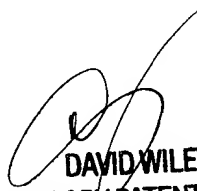
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

3X
mk

April 2, 2004


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100